

### **REMARKS/ARGUMENTS**

The Applicants hereby thank the Examiner for conducting the October 20, 2006, Telephonic Interview, for the observations in the outstanding Office, for disqualifying and withdrawing Weiser et al. (US 6599160) as a cited reference under 35 U.S.C. § 103(c), and for finding allowable subject matter in Claims 10 and 11. Independent Claims 4 and 10 are herein amended to better encompass the full scope and breadth of the present invention, notwithstanding the Applicants' belief that the claims would have been allowable as originally filed. Claim 7 is herein amended to depend from Claim 4 in light of canceled Claim 6. Accordingly, the Applicants respectfully assert that no claims have been narrowed within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 U.S.P.Q.2d (BNA) 1865 (Fed. Cir. 2000). Therefore, reconsideration of the present application in light of the foregoing amendment and these remarks is respectfully requested.

#### **I. Objection to Claims 4 and 10 on the Grounds of Informalities**

Claims 4 and 10 have been objected on the grounds of informalities. Claims 4 and 10 are herein amended to address these informalities by inserting "further" after "post[.]" Thus, the Applicants believe that Claims 4 and 10, as herein amended, overcome these grounds for objection on this basis. Therefore, the Applicants respectfully request that these grounds for objection on this basis be withdrawn and that Claims 4 and 10 be passed to allowance.

#### **II. Rejection of Claims 4-7 and 9-11, under 35 U.S.C. § 112, second paragraph**

Claims 4-7 and 9-11 have been rejected, under 35 U.S.C. § 112, second paragraph, on the grounds of indefiniteness. The Applicants respectfully traverse the Examiner's grounds for rejection on this basis.

Claim 4 is herein further amended by deleting "a" and instead inserting "the" before "coil spring" and by deleting "for" before "facilitating displaceable suspension of the appendage in relation to the body[.]" Claim 6 has been previously canceled, without

prejudice. As such, the Applicants respectfully submit that the Examiner's ground for rejection of Claim 6 on this basis has been rendered moot. Claim 7 is herein amended to depend from Claim 4. Claim 10 is herein further amended by deleting "detached" before "novelty portions" and by inserting "a post and" before "a plurality of securing prongs[.]"

Thus, the Applicants believe that Claims 4 and 10, as herein amended, overcome these grounds for rejection on this basis and that Claims 5, 7, 9, and 11 overcome these grounds for rejection by dependency. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn and that Claims 4, 5, 7 and 9-11 be passed to allowance.

### **III. Rejection of Claims 4 and 9-11 under 35 U.S.C. § 103(a) on the Ground of Higdon (US 5375363), in view of Moore et al. (US 5716161) and Del Mas (US 2760303)**

Claims 4 and 9-11 have been rejected, under 35 U.S.C. § 103(a), as being unpatentable over Higdon (US 5375363), in view of Moore et al. (US 5716161) and Del Mas (US 2760303). The Examiner asserts that, with respect to Claim 4, Higdon teaches a body 12, an appendage 16, and a connecting structure 354 and that Moore teaches prongs that extend away from a post 40 and toward a second end of the post 40 to manually install a connecting structure to apertures and quickly remove the connection structure from the apertures without using tools. The Examiner concedes that, in Higdon, "the prongs 364 do not extend away from the post toward a second end of the post" as discussed, *supra* (June 2, 2006, Final Office Action, p. 3). The Examiner has previously conceded that "Del Mas fails to disclose the post comprising prongs flexibly coupled to a first end of the post, and the prongs extending towards the body to terminate at respective termini" (June 2, 2006, Final Office Action, p. 6), but relies on Higdon. The Applicants hereby respectfully traverse these grounds for rejection on this basis.

With respect to Higdon, this reference merely teaches a decoy having a movable neck, the decoy comprising a neck-to-body connector 354 having a pair of flexible ears 364 projecting therefrom and for inserting into a hole 366 of the body 312 (col. 3, l. 67 – col. 4, l. 6). Referring to Figures 3 and 10, Higdon discloses *only two ears* 364 which subtend an

*obtuse angle* with the ring structure A2. Further, the term “ears” and the ring structure A2 are low aspect ratio elements by their definition and as shown and described throughout the Specification and drawings of Higdon. The Examiner concedes that, in Higdon, “the prongs 364 do not extend away from the post toward a second end of the post” (June 2, 2006, Final Office Action, p. 3).

Regarding Moore, this reference merely teaches a retainer clip having a threaded shank with a T-head embedment molded in a hex nut head for rotatably threading the clip into a support. Moore’s retainer clip is a fastener which is **necessarily fixedly disposed** by virtue of “threading the clip into a support” (Abstract). The very purpose of the Moore invention is for retaining a planar sheet material member, such as automotive trim, to an underlying support, such as an automotive body (col. 1, ll. 6-7). As such, Moore even teaches against the present invention claimed features of “a *displaceably suspended* manner” and “the at least one *flexible connecting member comprising a coil spring*” (Claim 4).

With respect to Del Mas, this reference merely teaches that “**Armholes** 15 are adapted to receive .... arm **stumps** comprising plugs 16” (col. 2, ll. 25-28). Further, the term “**stumps**” are **low aspect ratio elements by their definition** and as shown and described throughout the Specification and drawings of Del Mas.

Nowhere, in Higdon, evening view of Moore and Del Mas, is any express or even implied suggestion to combine the presently claimed elements of independent Claims 4 and 10. Independent system Claims 4 and 10, as herein amended, recite the following features believed to be patentably distinct from Higdon, even in view of Moore and Del Mas:

4. A novelty system comprising:
  - a body having a plurality of apertures;
  - one or more appendages corresponding to one or more said plurality of apertures and for securement to project in a displaceably suspended manner from said body, each said appendage including at least one flexible connecting member, the at least one flexible connecting member comprising a coil spring;
  - a connecting structure that secures said one or more appendages to said body, the connecting structure comprising a post with a first end, a middle portion, and a second end, and a plurality of securing prongs flexibly coupled to the first end of said post and adapted to be inserted through said plurality of apertures and retained therein, said securing prongs extending elastically

towards said body to terminate at respective termini for engagement therewith, and the plurality of securing prongs extending away from said post and toward the second end of said post, one end of said flexible connecting member connected to said connecting structure and another end connected to said appendage,

*the coil spring facilitating displaceable suspension of the appendage in relation to the body, the coil spring comprising a first coil portion and a second coil portion, the coil spring further comprising an L-shaped configuration being formed by the first coil portion and the second coil portion, the post being coaxially inserted into a first end of the coil spring, and the post further comprising a barrier for stopping removal of the coil spring from the post, and the barrier being disposed between the first coil portion and the second coil portion.*

10. A kit for constructing a novelty comprising:

a plurality of novelty portions combinable for shipping said novelty in at least a partially unassembled form, said novelty portions comprising a body with apertures for receiving connecting structures, one or more appendages including *at least one flexible connecting member comprising a coil spring* extending therefrom, and connecting structures for facilitating connection of said appendages to said body by connecting one end of said flexible connecting member to one of said connecting structures and connecting another end to said body,

said one or more appendages being securable upon assembly of said novelty to project *in a displaceably suspended manner* from said body by operatively connecting said connecting structures with said apertures of said body, *each said connecting structure comprising a post and a plurality of securing prongs flexibly coupled to a first end of each said connecting structure to extend towards said body*, and said securing prongs terminating at respective termini for engaging said body,

*the coil spring facilitating displaceable suspension of the appendage in relation to the body, the coil spring further comprising an L-shaped configuration, the post being coaxially inserted into a first end of the coil spring, and the post further comprising a barrier for stopping removal of the coil spring from the post.*

The Applicants respectfully submit that the limitation of herein amended Claim 4, "*the coil spring facilitating displaceable suspension of the appendage in relation to the body, the coil spring comprising a first coil portion and a second coil portion, the coil spring further comprising an L-shaped configuration being formed by the first coil portion and the second coil portion, the post being coaxially inserted into a first end of the coil spring, and the post*

*further comprising a barrier for stopping removal of the coil spring from the post, and the barrier being disposed between to first coil portion and the second coil portion[.]*” is not taught, motivated, or suggested by the cited references. The fastener of Moore is configured in a manner to achieve exactly the opposite structure from that of the present invention, i.e., Moore’s fastener must keep the trim on the car without flopping. The combination of the coil spring features, the displaceable suspension, and the remaining features of the present invention are not suggested or motivated by Higdon, Moore, or Del Mas, individually or together.

Further, the Examiner states, with respect to allowable subject matter found in Claims 10 and 11, that “[t]here is no motivation, absent applicant’s own disclosure, to modify Higdon, because there is no requirement to make the coil spring L-shaped” (Office Action, p. 7, para. 1). Herein amended independent Claims 4 and 10 **both** positively recite that the coil spring further comprises an **L-shaped configuration**.

Thus, the Applicants respectfully submit that Higdon, even in view of Moore and Del Mas, does not teach, motivate, or suggest the limitations of herein amended independent Claims 4 and 10 or those of Claims 9 and 11, by dependency. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn and that Claims 4 and 9-11 be passed to allowance.

**IV. Rejection of Claims 5-7 under 35 U.S.C. § 103(a) on the Ground of Higdon (US 5375363), in view of Moore et al. (US 5716161) and Del Mas (US 2760303), as applied to Claims 4 and 9, and in further view of Polk (US 2792022)**

Claims 5-7 have been rejected, under 35 U.S.C. § 103(a), as being unpatentable over Higdon (US 5375363), in view of Moore et al. (US 5716161), as applied to Claims 4 and 9, and in further view of Polk (US 2792022). The Examiner concedes that Higdon does not teach that the appendage can be a wing structure, but relies on Weiser for the teaching. The Examiner further concedes that, in Higdon, “the prongs 364 do not extend away from the post toward a second end of the post” as discussed, *supra* (June 2, 2006, Final Office Action, p. 3),

but relies on Moore for teaching a “stiff” fastener. The Examiner has previously conceded that “Del Mas fails to disclose the post comprising prongs flexibly coupled to a first end of the post, and the prongs extending towards the body to terminate at respective termini” (June 2, 2006, Final Office Action, p. 6). The Examiner relies on Polk for its teaching of an appendage comprising a wing structure. The Applicants hereby respectfully traverse these grounds for rejection on this basis.

Claim 5 is has been previously amended to recite: “The novelty system of Claim 4, wherein said one or more appendages comprises a wing structure.” Claim 6 is herein canceled, without prejudice, as discussed, *supra*, thereby rendering moot its previous ground for rejection. In light of the previous cancellation of Claim 6, Claim 7 now depends from Claim 4. Claims 5 and 7 further subsume the limitations of herein amended Claim 4 by dependency.

Reiterating, Higdon merely teaches a decoy having a movable neck, the decoy comprising a neck-to-body connector 354 having a pair of flexible ears 364 projecting therefrom and for inserting into a hole 366 of the body 312 (col. 3, l. 67 – col. 4, l. 6). Referring to Figures 3 and 10, Higdon discloses *only two ears* 364 which subtend an *obtuse angle* with the ring structure A2. Further, the term “ears” and the ring structure A2 are low aspect ratio elements by their definition and as shown and described throughout the Specification and drawings of Higdon. The Examiner concedes that, in Higdon, “the prongs 364 do not extend away from the post toward a second end of the post” (June 2, 2006, Final Office Action, p. 3).

As discussed, *supra*, Moore merely teaches a “stiff” retainer clip having a threaded shank with a T-head embedment molded in a hex nut head for rotatably threading the clip into a support. Moore’s retainer clip is a fastener which is **necessarily fixedly disposed** by virtue of “threading the clip into a support” (Abstract). The very purpose of the Moore invention is for retaining a planar sheet material member, such as automotive trim, to an underlying support, such as an automotive body (col. 1, ll. 6-7). As such, Moore even teaches against the present invention claimed features of “a *displaceably suspended* manner” and “the at least one *flexible connecting member comprising a coil spring*” (Claim 4).

With respect to Del Mas, this reference merely teaches that “**Armholes 15** are adapted to receive ... arm **stumps** comprising plugs 16” (col. 2, ll. 25-28). Further, the term “**stumps**” are **low aspect ratio elements by their definition** and as shown and described throughout the Specification and drawings of Del Mas.

Regarding Polk, the Applicants respectfully submit that this reference merely teaches a toy bird having wings being connected by a *linear fastener* (Figs. 1-9). Higdon, even in view of Moore and Del Mas, and even in further view of Polk, does not teach, suggest, or motivate the presently claimed coil spring being disposed around a post. Polk actually teaches that “the inner end of the wing 11 is provided with a slot 30 in which a spring 31 is positioned[;] and the wing 12 is provided with a similar slot 32 in which a spring 33 is positioned” (col. 2, ll. 43-46; Fig. 5). As such, the linear spring member of Polk is actually disposed in a slot.

The Applicants respectfully resubmit that the limitation “the coil spring facilitating displaceable suspension of the appendage in relation to the body, **the coil spring further comprising an L-shaped configuration**, the post being coaxially inserted into a first end of the coil spring, and the post further comprising a barrier for stopping removal of the coil spring from the post” is not taught, motivated, or suggested by the cited references.

Reiterating, the Examiner states, with respect to allowable subject matter found in Claims 10 and 11, that “[t]here is no motivation, absent applicant’s own disclosure, to modify Higdon, because there is no requirement to make the coil spring L-shaped” (Office Action, p. 7, para. 1). Herein amended independent Claim 4 positively recites that the coil spring further comprises an **L-shaped configuration**. As such, Claims 5 and 7 subsume this limitation by dependency.

Thus, the Applicants respectfully submit that Higdon, even in view of Moore and Del Mas, and even in further view of Polk, does not teach, motivate, nor suggest the limitations of previously presented Claims 5 and 7. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn and that Claims 5 and 7 be passed to allowance.

#### **IV. Allowable Subject Matter in Claims 10 and 11**

Claims 10 and 11 have been found to be allowable if rewritten to overcome the objection on the grounds of informalities as well as the rejection of the claims under 35 U.S.C. § 112, second paragraph. The Applicants hereby reiterate their thanks for the finding of allowable subject matter.

Claim 10 is herein amended, as discussed, supra. Claim 11 has been previously presented and recites: "The kit of Claim 10, wherein said connecting structures are insertable into said apertures."

Thus, the Applicants respectfully submit that herein amended Claim 10 overcomes the objection on the grounds of informalities as well as the rejection of the claims under 35 U.S.C. § 112, second paragraph. Therefore, the Applicants respectfully request that Claims 10 and 11 be passed to allowance.



PATENT

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CONCLUSION

Accordingly, independent Claims 4, 7, and 10 are herein amended to better encompass the full scope and breadth of the present invention, notwithstanding the Applicants' belief that the claims would have been allowable as originally filed. The Applicants respectfully reassert that no claims have been narrowed within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 U.S.P.Q.2d (BNA) 1865 (Fed. Cir. 2000). Therefore, reconsideration of the present application in light of the foregoing amendment and these remarks is respectfully requested. *The Examiner is further cordially invited to telephone the undersigned for any reason which would advance pending Claims 4, 5, 7, and 9-11 to allowance.*

Respectfully submitted,

CISLO & THOMAS LLP

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Daniel M. Cislo

Reg. No. 32,973

DMC/MLD:sc

Enclosures:

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Acknowledgment Postcard

CISLO & THOMAS LLP  
233 Wilshire Boulevard, Suite 900  
Santa Monica, California 90401  
Tel: (310) 451-0647  
Fax: (310) 394-4477  
[www.cislo.com](http://www.cislo.com)

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